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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Catherine Anne Abbott et al.	)	
		)	
Application No.	10/070,464	)	
		)	
Filed:	July 18, 2002	)	Group Art Unit: 1652
		)	
For:	DIPEPTIDYL PEPTIDASES	)	
		)	
Examiner:	Sheridan L. Swope	)	Attorney Docket No. FSCB-100

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D. C. 20231

Sir:

In response to the Office Action dated 21 February 2003 on the above-identified application, applicants provisionally elect for further prosecution at this time the claims of Group I, i.e., claims 1-9 and 24 directed to protease proteins. This election is made with traverse.

Reconsideration of the outstanding 7-way restriction requirement is requested. The claims in this application clearly relate to the same inventive concept, and have already been searched as evidenced by the International Preliminary Examination Report, thus no undue burden would be placed on the Examiner if these claims were to be examined together. Moreover, Kawakami et al. 2000, referred to by the Examiner in the outstanding Office Action, is not available to establish the state of the art inasmuch as the reference date of Kawakami et al., 22 February 2000, is after the claimed priority date of Australian PQ 5709.

As recognized by the Examiner, the subject matter of the claims have a disclosed relationship relative to one another and are, therefore, not independent. In light of the existing statutory and regulatory criteria (35 U.S.C. §121 and 37 C.F.R. §1.141) the present 7-way restriction requirement cannot be maintained inasmuch as the claimed inventions are not independent from one another.

It is also noted that the Requirement for Restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142 but is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. See, for example, Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); aff'd 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). Therefore, to promote the interest of both the public as well as the applicants, the Restriction Requirement should not be imposed without a specific analysis which supports the conclusions that two or more independent and distinct inventions are indeed claimed in one application.

In addition, the courts have recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a detailed disclosure of all aspects of their invention. The Court has observed:

> We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Furthermore, applicants respectfully submit that in view of increased Official Fees as well as the need to file divisional applications substantially concurrently, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the process of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Contrary to the notation on the Office Action Summary, a list of the certified copies of priority documents not received was not provided in the attached Office Action. During a telephone conference on 13 March 2003, the Examiner revealed that Australian Application PQ 2762 09/10/1999 was not received. This particular priority document will be submitted as soon as it is received by the undersigned.

Respectfully submitted,

March 21, 2003

By _____
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